

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In the Patent Application of

Jesse J. Williams
Eric J. Hansen and
Lindsay M. Ulman

Group Art Unit: 1796

Serial No.: 10/604,780

Examiner: Lorna M. Douyon

Filed: August 15, 2003

For: MANUAL SPRAY CLEANER

Our Ref: 71189-1501

REPLY TO EXAMINER'S ANSWER TO APPELLANTS' APPEAL BRIEF

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Commissioner for Patents
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Sir:

This paper is a reply to the Examiner's Answer, mailed November 5, 2008, in accordance with the provisions of 37 C.F.R. § 41.41.

NEW ISSUES TO BE REVIEWED ON APPEAL

The Examiner has raised new issues regarding the rejection of claims 49, 51, 52, 54, 96-98 and 115 under 35 U.S.C. § 103(a) based on U.S. Patent No. 3,488,287 to Seglin et al. (Seglin et al. '287). This Reply will address several new issues raised by the Examiner in the Answer, and supplements the arguments made by Appellants in their Appeal Brief.

A. The Tait publication has been improperly ignored.

The Examiner has improperly ignored the Tait publication because it is not a prior art reference and, as a result, has failed to properly determine the scope and content of the prior art based on the evidence of record. *Examiner's Answer*, p. 12, ln. 3-6. In addition, in failing to consider the Tait publication, the Examiner has ignored relevant rebuttal evidence to the extent that the Examiner has established a *prima facie* case of obviousness with Seglin et al. '287.

The Tait publication is not cited as prior art but is submitted as evidence in support Appellants' argument that one of ordinary skill in the art would not package a hydrogen peroxide and aerosol composition in an unlined aluminum container. *Appeal Brief*, p. 8, ln. 12-29 – p. 9, ln. 1-7; *Evidence Appendix, Exhibit 1*. The Tait publication discloses an expert view at least as late as July 12, 2006 that an aerosol cannot be stored in an unlined aluminum container. It follows that one of ordinary skill in the art at the time of the Appellants' invention would not have interpreted the Seglin et al. '287 reference as teaching that hydrogen peroxide and an aerosol composition can be stored in an unlined aluminum container.

In failing to consider the Tait publication, the Examiner has failed to correctly determine the scope and content of the prior art and further failed to establish the level of one of ordinary skill in the art, both of which are factors in determining obviousness under *Graham v. John Deere Co*, 383 U.S. 1; 86 S. Ct. 684; 15 L. Ed. 2d 545 (1966). In addition to the Tait publication, Appellants have submitted the testimony of three experts, Dr. Tait, Mr. Johnsen and Mr. Hansen, to support the Appellants' position on how one of ordinary skill in the art would interpret the disclosure of Seglin et al. '287. The Examiner has failed to find any evidentiary support for her interpretation of the disclosure of Seglin et al. '287 or her determination of the level ordinary

skill in the art over the wealth of evidence supplied by the Appellants to the contrary. For these reasons, the Examiner has failed to meet her burden to establish a *prima facie* case of obviousness under 35 U.S.C. 103.

B. The Hansen and Johnsen Declarations have been incorrectly interpreted

The Examiner has incorrectly construed the Hansen and Johnsen declarations as only supporting an argument for commercial success and incorrectly rejected the Hansen and Johnsen declarations for not being commensurate in scope with the claims. *Examiner's Answer*, p. 12, ln. 7-12 – p. 13, ln. 1-2.

1. The Examiner has ignored Appellants' evidence of the *Graham* secondary factor of unexpected results and has incorrectly interpreted Appellants' evidence as limited to the *Graham* secondary consideration of commercial success.

As discussed in the Appeal Brief filed September 8, 2008, the Hansen and Johnsen declarations along with the ignored Tait publication establish the unexpected and surprising results obtained by the Appellants in storing hydrogen peroxide and an aerosol in an unlined aluminum container. *Appeal Brief*, p. 9, ln. 2-29 – p. 10, ln. 1-9; p. 12, ln. 1-20. Unexpected results are an example of a secondary consideration that must be considered under *Graham v. John Deere Co.* in determining obviousness. The failure to consider the Appellants' evidence in support of the unexpected and surprising results obtained by the claimed invention is clear error. The Tait publication and the Hansen and Johnson Declarations are cogent rebuttal evidence of a secondary consideration that may overcome any alleged *prima facie* case of obviousness as required by *Graham*.

The Hansen and Johnsen Declarations along with the Tait publication establish that at the time of the invention, even experts in the field of aerosol and corrosion technology did not believe that an aerosol could be stably stored in an unlined aluminum container. This thinking was so entrenched in the field of aerosol technology that it took significant effort on the part of Appellants' assignee, BISSELL Homecare, Inc., to convince a manufacturer to produce an aerosol in an unlined aluminum container. *Appeal Brief*, p. 8, ln. 12-29; p. 9, ln. 1-29; p. 10, ln. 1-15.

"Expressions of disbelief by experts constitute strong evidence of nonobviousness." *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d

693, 698, 218 USPQ 865, 869 (Fed. Cir. 1983) (citing *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 483-484 (1966))...The skepticism of an expert, expressed before these inventors proved him wrong, is entitled to fair evidentiary weight, . . . as are the five to six years of research that preceded the claimed invention." *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988); *Burlington Industries Inc. v. Quigg*, 822 F.2d 1581, 3 USPQ2d 1436 (Fed. Cir. 1987). *MPEP* 716.05.

By viewing the Hansen and Johnsen declarations as only evidence in support of commercial success and ignoring the Tait publication, the Examiner has failed to fully consider the substantial evidence in rebuttal of any *prima facie* case of obviousness made by the Examiner.

2. The Examiner has further incorrectly ignored the Hansen Declaration in support of commercial success because the actual components of the cited OXYKIC/OxyDeep 2X spot cleaner are not set forth in the Hansen Declaration, arguing that it cannot be determined if the actual components in OXYKIC/OxyDeep 2X spot cleaner is commensurate in scope with the claims or not. *Examiner's Answer*, p. 12, ln. 13-18. However, the Hansen declaration clearly states in paragraph 3 that the OXYKIC/OxyDeep 2X spot cleaner is as described and claimed in the patent application. *Hansen declaration*, p.2, ln. 5-6.

The Examiner further argues that the declaration is not commensurate in scope with the claims because the alleged success was due to hydrogen peroxide, not any other peroxide composition as required in independent claim 49. Hydrogen peroxide is an exemplary form of a peroxide composition as set forth in claim 49. As noted in the MPEP:

“When considering whether proffered evidence is commensurate in scope with the claimed invention, Office personnel should not require the Appellant to show unexpected results over the entire range of properties possessed by a chemical compound or composition....an exemplary showing may be sufficient to establish a reasonable correlation between the showing and the entire scope of the claim, when viewed by a skilled artisan.” See, e.g., *Chupp*, 816 F.2d at 646, 2 USPQ2d at 1439; *Clemens*, 622 F.2d at 1036, 206 USPQ at 296. *MPEP*, 2145.

In any case, hydrogen peroxide is clearly defined in the specification as an exemplary type of peroxide according to the invention and is specifically claimed in dependent claim 52 as a peroxide composition. The Examiner's position that hydrogen peroxide is not commensurate

in scope with claim 49 and her resultant lack of consideration of the commercial success evidence is clear error.

C. A polyol humectant has been incorrectly equated with an anti-soil/anti-stain protectant

The Examiner's assertion that the polyol humectants of Seglin et al. '287 are equivalent with an anti-soil/anti-stain protectant (*Examiner's Answer*, p. 14, ln. 4-14) has no support in fact.

Humectants are known in the fields of dermatology and food science as hygroscopic organic compounds that attract and retain water. Humectants, examples of which include polyols or polyhydric alcohols such as glycerol, are used as food additives to keep food moist or in cosmetic compositions to retain moisture in organs such as the skin or eyes.

An anti-stain/anti-soil protectant, on the other hand, is used in the field of cleaning and surface protection and provides entirely different properties. An anti-stain/anti-soil protectant, examples of which are disclosed in the specification, repels soils and liquids to keep them from being absorbed onto or into a surface. *Application*, p. 27, ln. 2-9; p. 30, ln. 19-23; p. 10, ln. 1-3; p. 43, ln. 1-4. An anti-stain/anti-soil protectant, may be either a hydrophobic material or a material that provides a charged electrostatic barrier to repel soils and liquids.

The claimed invention is useful in cleaning carpet surfaces. The anti-soil/anti-stain protectant set forth in dependent claim 96 is used in carpet cleaning compositions. Humectants and anti-stain/anti-soil protectants are distinct types of chemicals used in unrelated fields to provide entirely different properties. They are by no means equivalents; when selecting an anti-stain/anti-soil protectant one of ordinary skill in the art would not be led to select a polyol humectant.

CONCLUSION

In view of the foregoing, it is submitted that the rejection of claims 49, 51-52, 54-59, 94-99 and 115 is improper and should not be sustained. Therefore, a reversal of the rejections of claims 49, 51-52, 54-59, 94-99 and 115 on all grounds is respectfully requested.

Respectfully submitted,

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